PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Jerding, Dean F., *et al.* — Group Art Unit: 2623

Serial No.: 09/590,434 — Examiner: Beliveau, Scott E.

Filed: June 9, 2000 — Docket No. A-6594 (191910-1480)

Title: VIDEO PROMOTIONAL AND ADVERTISING SYSTEMS FOR VDEO ON DEMAND SYSTEM

REMARKS IN SUPPORT
OF PRE-APPEAL BRIEF CONFERENCE

Mail Stop: AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants submit the following remarks in support of a Request for Pre-Appeal Brief Conference.

It is believed no extension of time is required. However, in the event that extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to deposit account no. 08-2025.

REMARKS

Applicant submits the following remarks in view of the final Office Action mailed May 11, 2006. Claims 134 – 138 remain pending.

I. Rejections under 35 U.S.C. §103 are Improper

Claims 134 – 138 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Number 6,628,302 ("*White*") in view of U.S. Patent Number 5,838,314 ("*Neel*"), "Bee" Article ("*Bee*"), and further in view of U.S. Patent Number 5,914,746 ("*Mathews*").

A review of the cited references, however, reveals that the cited art does not teach each and every limitation of Applicants' claims as is required by 35 U.S.C. § 103. More specifically, Applicants submit that there are clear errors in these rejections and that there is an omission of one or more essential elements for a prima facie rejection. Accordingly, Applicants respectfully traverse this rejection of claims 134 – 138, and respectfully submit that this rejection is improper.

A. Claims 134 and 135

As provided in independent claim 134, Applicants claim:

> A television set-top terminal ("STT") coupled to a server via a bi-directional communication network, said STT comprising:
>
> memory having at least one program code stored therein;
>
> at least one processor that is programmed by the program code to enable the STT to:
>
> receive via tuner in the STT media guide data corresponding to a media guide for on-demand rentable video presentations;
>
> provide a media guide presentation to a user via a television signal, the media guide presentation comprising at least a portion of the media guide data corresponding to a plurality of on-demand rentable video presentations;
>
> responsive to presentation specific rent flags received from the server, enable a plurality of user-selectable rental options specific to each one of the plurality of on-demand rentable video presentations in the media guide presentation;
>
> configure ***a first rental option*** in the plurality of user-selectable rental options to provide a user-selectable option to ***view a user-selected on-demand rentable video presentation without presentation promotional advertising that is otherwise shown during presentation*** of the user-selected on-demand rentable video presentation;
>
> configure ***a second rental option*** in the plurality of user-selectable rental options to provide a user-selectable option to ***view a user-selected***

on-demand rentable video presentation without preceding movie trailers that are otherwise shown immediately prior to presentation of the user-selected on-demand rentable video presentation;

receive a first user input corresponding to a selection of one of the plurality of on-demand rentable video presentations in the media guide presentation;

provide the first rental option and the second rental option to the user responsive to the first user input;

receive a second user input responsive to providing the first rental option and the second rental option;

provide the one of the plurality of rentable video presentations to the user without presentation promotional advertising during the presentation and without preceding movie trailers responsive to the second user input corresponding to the selection of the first rental option and the second rental option; and

suspend the provision of the rentable video presentation and provide the user with suspension promotional advertising responsive to third user input, wherein the suspension promotional advertising provided during suspension of the presentation is configured by the server and is independent of the presentation and independent of the first rental option and the second rental option. ***(emphasis added)***

Applicants submit that neither *White*, *Neel, Bee*, nor *Mathews* separately or in combination, disclose, teach, or suggest at least the features emphasized in bold text above. More specifically, the Final Office Action asserts a combination that includes *Neel* and *Bee*. *Neel* discloses "a graphics screen [that] asks the user if he or she wants to be billed for the movie or, instead, if they want to watch one or more advertisements and have the advertisers pay for the movie" (see also *Neel* col. 17, line 46). Additionally, FIG. 7a of *Neel* illustrates the option discussed above as allowing a user to "be charged $4.95 for the movie" or "be shown a fifteen minute interactive advertisement." *Bee* discloses a relationship between movie trailers and advertisements. Applicants submit that these references fail to disclose one or more claimed element essential for a proper rejection.

Applicants respectfully submit that, in this rejection, the examiner omitted one or more essential elements necessary to make this rejection. More specifically, none of the references, independently or in combination, disclose a "***a first rental option***... to ***view a user-selected on-demand rentable video presentation without presentation promotional advertising that is otherwise shown during presentation*** of the user-selected on-demand rentable video presentation ***[and] a second rental option*** in the plurality of user-selectable rental options to provide a user-selectable option to ***view a user-selected on-demand rentable video presentation without preceding movie trailers that are otherwise shown immediately***

prior to presentation of the user-selected on-demand rentable video presentation" as recited in claim 134. The Advisory Action asserts "[t]he Neel et al. reference teaches that the user is provided with 'selectable options' for the user to choose (or conversely not choose) to watch one or more commercials/advertisements..." (AA p. 3, line 7). However, neither this reference, nor any of the other cited references disclose "a second rental option..." as recited in claim 1. As such, one or more essential elements for a proper rejection is omitted. For at least this reason, Applicants submit that the rejection is improper and should be withdrawn.

Additionally, the Final Office Action of 5/11/06 (p. 10, line 6) cites *Bee* to apparently indicate that a movie may be associated with a trailer as a form of advertisement. The Final Office Action asserts that combining *Bee* with *Neel* renders obvious claim 134 because "movie trailers are advertisements" (FOA p. 10, line 7). Applicants respectfully submit that inclusion of this reference constitutes clear error in that the combination of *Neel* and *Bee* fails to disclose a "second selectable option" as recited in claim 134. For at least this additional reason that this rejection constitutes clear error, Applicants submit that this rejection is improper and should be withdrawn.

In view of the foregoing, the cited art clearly does not render obvious claim 1. The cited art therefore also does not render obvious claim 135, which depends from claim 134.

B. <u>Claims 136 – 138</u>

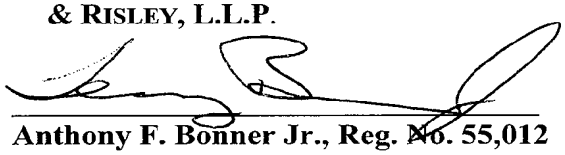
Claims 136 – 138 are also allowable for at least the reason that these claims depend from allowable independent claim 134. Applicants respectfully submit that the addition of U.S. Patent number 6,628,302 ("*Kikinis*") has no effect on the patentability of any of the claims 134 – 138. Applicants also note that, in addition to the arguments set forth above, the claims that depend from claim 134 contain one or more additional elements that are not taught by the cited art. However, for at least the additional reason that claims 136 – 138 depend from claim 134, Applicants submit that the cited art does not render claims 136 – 138 unpatentable.

II. Conclusion

As is apparent from the foregoing, the cited art is woefully deficient in rendering Applicants' claims unpatentable. Therefore, application of *White* in view *Neel*, *Bee*, and *Mathews* against Applicants' claims under 35 U.S.C. §103 rises to the level of clear legal and/or factual error. Applicants therefore request that the rejections of the final Office Action be withdrawn and a new, non-final Office Action, or Notice of Allowance, be issued.

Respectfully submitted,

THOMAS, KAYDEN, HORSTEMEYER & RISLEY, L.L.P.



Anthony F. Bonner Jr., Reg. No. 55,012

100 Galleria Parkway, NW
Atlanta, GA 30339
Phone: (770) 933 - 9500
Fax: (770) 951 - 0933